



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,105	04/16/2004	Mark D. Soll	MER 04-024	9262

7590 01/28/2008  
Judy JARECKI-BLACK, Ph.D., J.D.  
3239 Satellite Blvd.  
Duluth, GA 30096

EXAMINER
----------

LEVY, NEIL S

ART UNIT	PAPER NUMBER
----------	--------------

1615

MAIL DATE	DELIVERY MODE
-----------	---------------

01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/826,105	SOLL ET AL.	
	Examiner	Art Unit	
	NEIL LEVY	1615	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-25, 30-32 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-29 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Foreign patents and non-patent publications can not be incorporated by reference; neither can future references during prosecution be incorporated.

### ***Election/Restrictions***

Applicant's election with traverse of Group VIII, species of formula II, with R<sub>2</sub>=SO CF<sub>3</sub>, R<sub>4</sub>=amino, Ar=2, 6-dichloro-4-CF<sub>3</sub> phenyl, solvent=DGME and avermectin as the second parasiticide in the reply filed on 12/12/07 is acknowledged. The traversal is on the ground(s) that there is no serious burden, linking claims should be examined to the product & methods of making & using. This is not found persuasive because there is indeed a serious burden to examining & searching all inventions. Claims to chewables and tablets remain non-elected-components of the claims are standard feed, not topical, ingredients

The requirement is still deemed proper and is therefore made FINAL.

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product

claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 1-25, 30-32, 34-36 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/12/07 . and interview of 1/9/08.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 26-29, 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

H<sub>2</sub>N-CS is seen to mean H<sub>2</sub>N-C=S-; however, page 22 shows C=S connected to formula II, while page 37 shows -S- connected to formula III; which is connected to pyrazole, S or C ?

C (S) NH<sub>2</sub> at formula II, column 10 of 7262214 is assumed to be the intended format, but the specification of the instant fails to show this.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26-29 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated ALIG et al 6518296

ALIG shows the instant (Table 14, R2=CF<sub>3</sub>, R3=NH<sub>2</sub>) as compositions of the instant claimed formulation components, paraffin, oils, and organic solvents (column 24, top).

As of the SOLL invention with corn cobs and meals (column 24, lines 16-18) with surfactants (lines 18-23). Additional actives include avermectins (column 26, bottom).

Oral formulations for cattle, pets and other animals are at column 29, top.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26-29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over SOLL et al 7262214 and ALIG et al 6518296 in view of BUNTAIN et al 4963575.

SOLL: see column 14, IV, when R301=CSNH<sub>2</sub>, at column 17 R302=CF<sub>3</sub>, R103=haloalkyl R303=amino and Ar is the aryl of II-A or III-B at column 18 and I-B at column 10. Added active includes avermectin (column 6, lines 55-59) with formulations including vehicles and carriers to solute and formulate as either topical or dietary forms (column 3, lines 5-9) as is known in the art. The carriers include solvents, DGME, ethanol and waxes (column 7, top) and antioxidants (column 26, bottom) but were not further described as oral compositions.

SOLL shows equivalent actives include formula I-B, fipronil (column 10).

ALIG shows the instant )Table 14, R2=CF<sub>3</sub>, R3=NH<sub>2</sub>) as compositions of the instant claimed formulation components, paraffin, oils, and organic solvents (column 24, top). As of the SOLL invention with corn cobs and meals (column 24, lines 16-18) with surfactants (lines 18-23). Additional actives include avermectins (column 26, bottom). Oral formulations for cattle, pets and other animals are at column 29, top.

BUNTAIN teaches N-phenylpyrazoles (column 10, lines 54, 55) similar to the instant fipronil can be formulated to control pet ectoparasites and endoparasites (column 17) as both oral and topical compositions (column 18, lines 15-35) inclusive of medicated feeds. Also, is added avermectin (column 20, lines 5, 15). The actual compositions are concentrates and supplements, the instant premix, for mixing with feedstuffs (column 20, lines 39-47).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize pest control means, to use any of art recognized means, as of the SOLL formulations, modified as desired to permit application in feeds for animals.

It would be obvious to vary the form of the formulations to optimize the effect desired, depending upon the particular species and application method of interest, reduction of toxicity, cost minimization, enhanced, and prolonged, or synergistic effects.

Applicant has not provided any objective evidence of nonobvious or unexpected results that the administration of the particular ingredients' combination or formulation provides any greater or different level of prior art expectation as claimed, and the use

Application/Control Number:  
10/826,105  
Art Unit: 1615

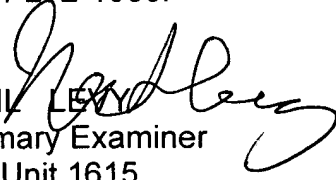
Page 6

of ingredient for the functionality for which they are known to be used is not basis for patentability.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
NEIL LEVY  
Primary Examiner  
Art Unit 1615